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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,771	07/20/2004	Matthew D Walker	36-1832	7138

23117 7590 06/30/2010

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EXAMINER	
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ART UNIT	**PAPER NUMBER**
2621	
MAIL DATE	**DELIVERY MODE**
06/30/2010	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MATTHEW D. WALKER, ADRIAN R. THURLOW,
and STEPHEN M. WEBSTER

Appeal 2009-011213
Application 10/501,771
Technology Center 2600

Decided: June 30, 2010

Before KENNETH W. HAIRSTON, THOMAS S. HAHN, and
BRADLEY W. BAUMEISTER *Administrative Patent Judges*.

HAHN, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants invoke our review under 35 U.S.C. § 134 from the Examiner's final rejections of claims 1-10, 12, and 14. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was held on June 22, 2010. We reverse, and enter a new ground of rejection.

STATEMENT OF THE CASE

Appellants claim a video system and method for encoding images by generating (i) an encoded data set for a first image, and (ii) predictively encoded further data sets derived from decoded versions of previous first image data sets. A user selects another, or further, image. A first data set for the further image is generated by predictively encoding a decoded version of the previously generated *first image* data set, and further data sets are generated by predictively encoding decoded versions of previous *further image* data sets.[1] Claim 1 is illustrative:

> 1. A method of transmitting images, the method comprising:
>
> capturing a plurality of still images;
>
> generating a first set of data by encoding a first one of said still images;
>
> generating one or more further sets of data by predictively encoding the first image, wherein the predictive encoding is performed with respect to a decoded version of the first image associated with a previously generated set of data;
>
> in response to a user request which selects a further one of said still images, generating a first set of data representing the further image by predictively encoding the further image, wherein the predictive encoding is performed with respect to a decoded version of the first image associated with a previously generated set of data; and

[1] *See generally* Spec. 3:19-29; 4:1-4; 7:14-20; 9:18-23; 10:4, 5, 13-20; 12:18-28; Figs. 2 and 3.

generating one or more further sets of data representing the further image by predictively encoding the further image, wherein the predictive encoding is performed with respect to a decoded version of the further image associated with a previously generated set of data.

The appealed rejections rely on the following prior art references:

King	US 5,802,211	Sep. 1, 1998
Yavits	US 2003/0048847 A1	Mar. 13, 2003

The Examiner rejected:

1. Claims 1, 4-10, 12, and 14 under 35 U.S.C. § 102(e) as being anticipated by Yavits (Ans. 3-6);[2] and
2. Claims 2 and 3 under 35 U.S.C. § 103(a) as being unpatentable over Yavits and King (Ans. 6, 7).

APPELLANTS' ARGUMENTS

Appellants argue claim 1 (App. Br. 14-16; Reply Br. 2-5), and contend that the disputed limitations of claim 1 are similarly recited in the remaining independent claims, which also are rejected as being anticipated by Yavits (App. Br. 16). Appellants further argue that the rejected dependent claims, including those rejected as being obvious, are patentable because of incorporated base independent claim limitations not taught by Yavits (App. Br. 17, 18).

Appellants assert, *inter alia*, that Yavits fails to teach generating a first data set representing a selected further, e.g., a second, image by

[2] Claims 10, 12, and 14 are not listed in the statement of rejection (Ans. 3). We presume these are typographical errors because of discussions in the associated statement of reasons addressing claims 10, 12, and 14 (Ans. 6).

predictively encoding a decoded version of a previously generated *first image* data set (App. Br. 14; Reply Br. 3).

ISSUE

The pivotal issue is whether the Examiner erred in finding Yavits explicitly or inherently teaches generating a first set of data representing a further image by predictively encoding a decoded version of a previously generated set of data for a first image as recited in independent claim 1?

ANALYSIS

Anticipation Rejection

Relevant to this appeal are the following method claim 1 recitations:

1. generating a first set of data by encoding a first image;
2. generating further sets of data for the first image by predictively encoding decoded versions of previously generated sets of data for the first image;
3. selecting a further image; and
4. generating a first set of data representing the further image by predictively encoding a decoded version of a previously generated set of data for the first image.

The Examiner finds Yavits teaches both of claim 1 recited generating steps 2 (i.e., producing one or more data sets for the first image after it is encoded) and 3 (i.e., producing a first data set representing the further image). In particular, the Examiner identically describes the predictive encoding procedures for both of claim 1, steps 2 and 3, and finds Yavits teaches "predictive encoding (Fig. 6, 106 ["Motion Estimation Processor"])

is performed with respect to a decoded version of the first image associated with a previously generated set of data ([0080])" (Final Rej. 3).

Appellants variously argue that claim 1 is patentable, including asserting that Yavits fails to teach selecting a further image that is "encoded in relation to the previous progressively enhanced frame selected by the user" (App. Br. 14). More specifically, Appellants assert Yavits fails to teach producing a first data set for the further image by performing "'predictive encoding . . . with respect to a decoded version of the first image associated with a previously generated set of data,' as required by claim 1" (App. Br. 16; *see also* Reply Br. 3).

The Examiner acknowledges and addresses Appellants' contentions concerning "capturing still pictures" and "a user request to cause selection of a different frame" (Ans. 8). Additionally, the Examiner, in apparent conjunction with the claimed selecting a further frame, asserts Yavits discloses "a Motion JPEG standard, which you would use when dealing with still images (paragraph [0073] and [0173])" (*id.*). However, the Examiner does not provide any more explanation, citation to Yavits or other evidence of record addressing encoding a further frame. We do not find that Yavits, including the cited paragraphs [0073] or [0173], explicitly or inherently teaches the claim 1 recited generation of a first set of data representing a *further image* by predictively encoding a decoded version of a previously generated set of data for a *first image.* Consequently, we agree with Appellants, the Examiner erred in finding claim 1 anticipated by Yavits, because a claim only is anticipated if all the recited elements are expressly or inherently described in a single prior art reference. *Verdegaal Bros., Inc. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

For the foregoing reasons, the anticipation rejection of independent claim 1 cannot be sustained, nor can the anticipation rejection of the other independent claims 6, 7, or 9. Further, the anticipation rejection of claims 4, 5, 8, 10, 12, and 14 that incorporate the disputed limitations from base independent claims can not be sustained.

Obviousness Rejection

Appellants contend that the rejection of claims 2 and 3 under § 103(a), as being unpatentable over Yavits and King, should be reversed because Yavits is deficient, as addressed *supra*, and King does not make up for the deficiencies (App. Br. 18). We agree. Accordingly, we will not sustain the rejection of claims 2 and 3.

NEW GROUND OF REJECTION

Claims 10, 12, and 14 are rejected under 35 U.S.C. § 101 for non-statutory subject matter. Each of these claims recites a "computer readable medium encoded with computer executable instructions." We find these recitations cover both non-transitory and transitory subject matter. This construction is consistent with Appellants' Specification (17:26-30).[3] Accordingly, the claims are rejected under § 101 as encompassing non-statutory subject matter. *See In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter).

[3] At the oral hearing, Appellants' counsel indicated that amendment of these claims by narrowing them to read on "non-transitory" limited subject matter would be acceptable.

ORDER

We reverse the Examiner's rejection of claims 1-10, 12, and 14.

We have entered a new ground of rejection under 37 C.F.R. § 41.50(b) for claims 2 and 3 under 35 U.S.C. § 101.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that "[a] new ground of rejection.., shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .
>
> (2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED - 37 C.F.R. § 41.50(b)

KIS

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